

## **REMARKS**

By this amendment, Claims 20 and 27 are amended, and new Claim 37 is added. The amended claims and the new claim are supported by the specification at page 10, lines 4-11 (Claims 20 and 27), and at page 10, lines 12-14 (new Claim 37). No new matter has been introduced. Claims 16-20, 22-24 and 27-37 are pending in this application. Reconsideration of the pending claims in view of the arguments/comments below is earnestly requested.

### **Rejections under 35 U.S.C. §103**

Claims 16, 17, 20, and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,241,983 to Paul et al. (hereinafter “Paul”) for reasons stated on pages 2-3 of the Office Action. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP §2142. Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

MPEP §2143.01.

Independent Claim 20, as amended, is directed to a method for the inhibition or treatment of systemic infections in humans or vertebrates comprising administering, to humans or vertebrates having a systemic infection caused by pathogenic bacteria, a composition consisting essentially of an effective amount of a fermentable dietary fiber or a mixture of fermentable dietary fibers, and one or more pharmaceutically acceptable excipients, wherein the composition is administered orally or through tube feeding.

Paul generally teaches a composition for promoting gastrointestinal health containing a beneficial human intestinal microorganism and dietary fiber. The composition can further contain one or more immunoglobulins. Paul does not teach or suggest a composition “consisting essentially of an effective amount of a fermentable dietary fiber or a mixture of fermentable dietary fibers, and one or more pharmaceutically acceptable excipients,” as recited in Claim 20. In fact, Paul teaches away from any dietary fiber composition that does not contain a beneficial intestinal microorganism and/or immunoglobulin. For example, Paul provides “a dietary supplement containing dietary fiber without living intestinal bacteria that are beneficial for gastrointestinal health lack means for providing an inhibitory effect on the growth of pathogenic bacteria, reducing levels of toxic amines, and lowering the pH of the gastrointestinal tract.” (Col. 2, line 64 to col. 3, line 2). Paul further provides “prior art formulas that fail to include concentrated immunoglobulins lack means for binding and inactivating foreign antigens such as pathogenic bacteria...” (Col. 3, lines 11-14).

Moreover, Paul does not teach or suggest inhibition or treatment of systemic infections. The Examiner alleges that, by applying the disclosed Paul composition, one inherently rids the body of toxins, infections or parasites that reside in ones body, both systemically and locally. Applicants respectfully disagree.

First of all, in relying upon the theory of inherency, the Office Action must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Applicants respectfully submit that the Examiner has not provided any evidentiary support for her assertion that Paul’s composition would enable one to rid the body of systemic infections.

The Examiner asserts that pathogens can reside in the lungs, brain and blood and that it

would be obvious to one of ordinary skill in the art to utilize Paul's composition to aid in the elimination of this foreign material. Applicants fail to follow the Examiner's logic. Paul only teaches promoting gastrointestinal health using a composition containing dietary fiber and beneficial intestinal microorganism. It does not necessarily flow from the teaching that the composition would aid the elimination of bacteria in the lungs, brain and blood. If the Examiner's conclusion is based on a scientific theory, the Office Action has not provided any evidentiary support to substantial the Examiner's assertion. According to the MPEP, the rationale to support a rejection under 35 U.S.C. §103 may rely on logic and sound scientific principle. However, when an examiner relies on a scientific theory, evidentiary support for the existence and meaning of that theory must be provided. MPEP §2144.02.

In addition, obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established. In re Rijckaert, 28 USPQ2d 1955 (Fed. Cir. 1993). The therapeutic effect of dietary fiber on systemic infection was discovered by Applicants through experimentation and was not known at the time the invention was made.

Taken together, Applicants respectfully submit that Claim 20, as amended, is not obvious over Paul. Withdrawal of the 35 U.S.C. §103 rejection to Claim 20 is respectfully requested.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 5 USPQ2d 1596 (Fed Cir. 1988). Accordingly, dependent Claims 16, 17 and 22 are patentable because they depend from Claim 20 and define additional patentable subject matter. Withdrawal of the 35 U.S.C. §103 rejection to Claims 16, 17, and 22 is respectfully requested.

Claims 18, 19, 23 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Paul in view of U.S. Patent No. 6,500,805 to Van Loo et al. (hereinafter "Van Loo") for

reasons stated on pages 3-4 of the Office Action. Applicants respectfully traverse the rejection.

Claims 18, 19, 23 and 24 depend indirectly from Claim 20. As discussed above, Claim 20 is not obvious over Paul. Accordingly, Claims 18, 19, 23 and 24 are not obvious over Paul at least for the same reason, i.e., Paul does not teach or suggest treating systemic infection with a composition consisting essentially of a fermentable dietary fiber or a mixture of fermentable dietary fibers, and one or more pharmaceutically acceptable excipients. Van Loo does not cure this deficiency.

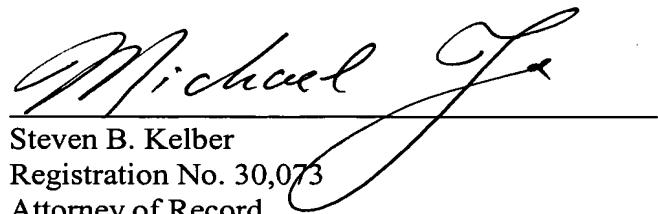
Van Loo generally describes treating colon cancer with a composition comprising fructan. It does not teach or suggest treating systemic infection using such a composition. Therefore, the combination of Paul and Van Loo does not render Claim 20, as well as dependent Claims 18, 19, 23 and 24, obvious. Accordingly, Applicants respectfully submit that Paul and Van Loo, individually or in combination, do not render Claims 18, 19, 23 and 24 obvious. Withdrawal of the 35 U.S.C. §103 rejection to Claims 18, 19, 23 and 24 is respectfully requested.

The Examiner has not provided a ground for the rejection of Claims 27-36. Applicants respectfully submit that Claims 27-36, as amended, are patentable for the same reasons detailed in the discussion of Claim 20. Applicants further submit that new Claim 37 is patentable over Paul and Van Loo because neither reference discloses treating systemic infections with a functional food composition comprising an effective amount of a fermentable dietary fiber or a mixture of fermentable dietary fibers.

In view of the foregoing remarks, favorable reconsideration of all pending claims is requested. Applicants respectfully submit that this application is in condition for allowance and requests that a notice of allowance be issued. Should the Examiner believe that anything further is required to expedite the prosecution of this application or further clarify the issues, the Examiner is requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

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**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

**In re Vaeck (CA FC) 20 USPQ2d 1438 In re Vaeck****U.S. Court of Appeals Federal Circuit  
20 USPQ2d 1438****Decided October 21, 1991  
No. 91-1120****Headnotes****PATENTS****1. Patentability/Validity - Obviousness - Combining references (§ 115.0905)**

Rejection of claimed subject matter as obvious under 35 USC 103 in view of combination of prior art references requires consideration of whether prior art would have suggested to those of ordinary skill in art that they should make claimed composition or device, or carry out claimed process, and whether prior art would also have revealed that such person would have reasonable expectation of success; both suggestion and reasonable expectation of success must be founded in prior art, not in applicant's disclosure.

**2. Patentability/Validity - Obviousness - Relevant prior art - Particular inventions (§ 115.0903.03)**

Patent and Trademark Office has failed to establish *prima facie* obviousness of claims for use of genetic engineering techniques for producing proteins that are toxic to insects such as larvae of mosquitos and black flies, since prior art does not disclose or suggest expression in cyanobacteria of chimeric gene encoding insecticidally active protein, or convey to those of ordinary skill reasonable expectation of success in doing so; expression of antibiotic resistance-conferring genes in cyanobacteria, without more, does not render obvious expression of unrelated genes in cyanobacteria for unrelated purposes.

**3. Patentability/Validity - Specification - Enablement (§ 115.1105)****JUDICIAL PRACTICE AND PROCEDURE****Procedure - Judicial review - Standard of review - Patents (§ 410.4607.09)**

Specification must, in order to be enabling as required by 35 USC 112, first paragraph, teach person skilled in art to make and use invention without "undue experimentation," which does not preclude some experimentation; enablement is question of law which is reviewed independently on appeal, although such determination is based upon underlying factual findings which are reviewed for clear error.

**PATENTS****4. Patentability/Validity - Specification - Enablement (§ 115.1105)**

Patent and Trademark Office did not err in rejecting, as non-enabling pursuant to 35 USC 112, first paragraph, claims for use of genetic engineering techniques for producing proteins that are toxic to insects such as larvae of mosquitos and black flies, in view of relatively incomplete understanding of biology of cyanobacteria as of applicants' filing date, as well as limited disclosure by applicants of particular cyanobacterial genera operative in claimed invention, since there is no reasonable correlation between narrow disclosure in applicants' specification and broad scope of protection sought in claims encompassing gene expression in any and all cyanobacteria.

**Case History and Disposition:**

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**Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.**

**Application for patent, serial no. 07/021,405, filed March 4, 1987, by Mark A. Vaeck, Wipa Chungjatupornchai, and Lee McIntosh (hybrid genes incorporating a DNA fragment containing a gene coding for an insecticidal protein, plasmids, transformed cyanobacteria expressing such protein and method for use as a biocontrol agent). From decision rejecting claims 1-48 and 50-52 as unpatentable under 35 USC 103, and rejecting claims 1-48 and 50-51 for lack of enablement, applicants appeal. Affirmed and part and reversed in part; Mayer, J., dissents with opinion.**

**Attorneys:**

**Ian C. McLeod, Okemos, Mich., for appellant.**

**Teddy S. Gron, associate solicitor (Fred E. McKelvey, solicitor and Richard E. Schafer, associate solicitor, with him on brief), for appellee.**

**Judge:**

**Before Rich, Archer, and Mayer, circuit judges.**

**Opinion Text****Opinion By:**

**Rich, J.**

This appeal is from the September 12, 1990 decision of the Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences (Board), affirming the examiner's rejection of claims 1-48 and 50-52 of application Serial No. 07/021,405, filed March 4, 1987, titled "Hybrid Genes Incorporating a DNA Fragment Containing a Gene Coding for an Insecticidal Protein, Plasmids, Transformed Cyanobacteria Expressing Such Protein and Method for Use as a Biocontrol Agent" as unpatentable under 35 USC 103, as well as the rejection of claims 1-48 and 50-51 under 35 USC 112, first paragraph, for lack of enablement. We reverse the § 103 rejection. The § 112 rejection is affirmed in part and reversed in part.

**BACKGROUND****A. The Invention**

The claimed invention is directed to the use of genetic engineering techniques 1 for production of proteins that are toxic to insects such as larvae of mosquitos and black flies. These swamp-dwelling pests are the source of numerous human health problems, including malaria. It is known that certain species of the naturally-occurring *Bacillus* genus of bacteria produce proteins ("endotoxins") that are toxic to these insects. Prior art methods of combatting the insects involved spreading or spraying crystalline spores of the insecticidal *Bacillus* proteins over swamps. The spores were environmentally unstable, however, and would often sink to the bottom of a swamp before being consumed, thus rendering this method prohibitively expensive. Hence the need for a lower-cost method of producing the insecticidal *Bacillus* proteins in high volume, with application in a more stable vehicle. As described by appellants, the claimed subject matter meets this need by providing for the production of the insecticidal *Bacillus* proteins within host cyanobacteria. Although both cyanobacteria and bacteria are members of the prokaryote 2 kingdom, the

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cyanobacteria (which in the past have been referred to as "blue-green algae") are unique among prokaryotes in that the cyanobacteria are capable of oxygenic photosynthesis. The cyanobacteria grow on top of swamps where they are consumed by mosquitos and black flies. Thus, when *Bacillus* proteins are produced within transformed 3 cyanobacterial hosts according to the claimed invention, the presence of the insecticide in the food of the targeted insects advantageously guarantees direct uptake by the insects.

More particularly, the subject matter of the application on appeal includes a chimeric (i.e., hybrid) gene comprising (1) a gene derived from a bacterium of the *Bacillus* genus whose product is an insecticidal protein, united with (2) a DNA promoter effective for expressing the *Bacillus* gene in a host cyanobacterium, so as to produce the desired insecticidal protein.

The claims on appeal are 1-48 and 50-52, all claims remaining in the application. Claim 1 reads:

1. A chimeric gene capable of being expressed in Cyanobacteria cells comprising:

(a) a DNA fragment comprising a promoter region which is effective for expression of a DNA fragment in a Cyanobacterium; and

(b) at least one DNA fragment coding for an insecticidally active protein produced by a *Bacillus* strain, or coding for an insecticidally active truncated form of the above protein or coding for a protein having substantial sequence homology to the active protein,

the DNA fragments being linked so that the gene is expressed.

Claims 2-15, which depend from claim 1, recite preferred *Bacillus* species, promoters, and selectable markers. 5 Independent claim 16 and claims 17-31 which depend therefrom are directed to a hybrid plasmid vector which includes the chimeric gene of claim 1. Claim 32 recites a bacterial strain. Independent claim 33 and claims 34-48 which depend therefrom recite a cyanobacterium which expresses the chimeric gene of claim 1. Claims 50-51 recite an insecticidal composition. Claim 52 recites a particular plasmid that appellants have deposited.

## **B. Appellants' Disclosure**

In addition to describing the claimed invention in generic terms, appellants' specification discloses two particular species of *Bacillus* ( *B. thuringiensis*, *B. sphaericus* ) as sources of insecticidal protein; and nine genera of cyanobacteria ( *Synechocystis*, *Anacystis*, *Synechococcus*, *Agmenellum*, *Aphanocapsa*, *Gloecapsa*, *Nostoc*, *Anabaena* and *Fremylium* ) as useful hosts.

The working examples relevant to the claims on appeal detail the transformation of a single strain of cyanobacteria, i.e., *Synechocystis* 6803. In one example, *Synechocystis* 6803 cells are transformed with a plasmid comprising (1) a gene encoding a particular insecticidal protein ("B.t. 8") from *Bacillus thuringiensis* var. *israelensis*, linked to (2) a particular promoter, the P<sub>L</sub> promoter from the bacteriophage Lambda (a virus of *E. coli* ). In another example, a different promoter, i.e., the *Synechocystis* 6803 promoter for the rubisco operon, is utilized instead of the Lambda P<sub>L</sub> promoter.

## **C. The Prior Art**

A total of eleven prior art references were cited and applied, in various combinations, against the claims on appeal. The focus of Dzelzkalns, 6 the primary reference cited against all of the rejected claims, is to determine whether chloroplast promoter sequences can function in cyanobacteria. To that end Dzelzkalns discloses the expression in cyanobacteria of a chimeric gene comprising a chloroplast promoter sequence fused to a gene encoding the enzyme chloramphenicol acetyl transferase (CAT). 7 Importantly, Dzelzkalns teaches the use of the CAT gene as a "marker" gene; this use of antibiotic resistance-conferring genes for selection purposes is a common technique in genetic engineering.

Sekar I, 8 Sekar II, 9 and Ganesan 10 collectively disclose expression of genes encoding certain *Bacillus* insecticidal proteins in the bacterial hosts *B. megaterium*, *B. subtilis* and *E. coli*.

Friedberg 11 discloses the transformation of the cyanobacterium *Anacystis nidulans* R2 by a plasmid vector comprising the O<sub>L</sub>P<sub>L</sub> operator-promoter region and a temperature-sensitive repressor gene of the bacteriophage Lambda. While the cyanobacteria are attractive organisms for the cloning of genes involved in photosynthesis,

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Friedberg states, problems may still be encountered such as suboptimal expression of the cloned gene, detrimental effects on cell growth of overexpressed, highly hydrophobic proteins, and rapid turnover of some gene products. To address these problems, Friedberg teaches the use of the disclosed Lambda regulatory signals in plasmid vehicles which, it states, have "considerable potential for use as vectors the expression of which can be controlled in *Anacystis* ...."

Miller 12 compares the initiation specificities *in vitro* of DNA-dependent RNA polymerases 13 purified from two different species of cyanobacteria ( *Fremyella diplosiphon* and *Anacystis nidulans* ), as well as from *E. coli*.

Nierzwicki-Bauer 14 identifies in the cyanobacterium *Anabaena* 7120 the start site for transcription of the gene encoding *rbc* L, the large subunit of the enzyme ribulose-1, 5-bisphosphate carboxylase. It reports that the nucleotide sequence 14-8 base pairs preceding the transcription start site "resembles a good *Escherichia coli* promoter," but that the sequence 35 base pairs before the start site does not.

Chauvat 15 discloses host-vector systems for gene cloning in the cyanobacterium *Synechocystis* 6803, in which the antibiotic resistance-conferring *neo* gene is utilized as a selectable marker.

Reiss 16 studies expression in *E. coli* of various proteins formed by fusion of certain foreign DNA sequences with the *neo* gene.

Kolowsky 17 discloses chimeric plasmids designed for transformation of the cyanobacterium *Synechococcus* R2, comprising an antibiotic-resistant gene linked to chromosomal DNA from the *Synechococcus* cyanobacterium. Barnes, United States Patent No. 4,695,455, is directed to the treatment with stabilizing chemical reagents of pesticides produced by expression of heterologous genes (such as those encoding *Bacillus* proteins) in host microbial cells such as *Pseudomonas* bacteria. The host cells are killed by this treatment, but the resulting pesticidal compositions exhibit prolonged toxic activity when exposed to the environment of target pests.

## **D. The Grounds of Rejection**

### **1. The § 103 Rejections**

Claims 1-6, 16-21, 33-38, 47-48 and 52 (which include all independent claims in the application) were rejected as unpatentable under 35 USC 103 based upon Dzelzkalns in view of Sekar I or Sekar II and Ganesan. The examiner stated that Dzelzkalns discloses a chimeric gene capable of being highly expressed in a cyanobacterium, said gene comprising a promoter region effective for expression in a cyanobacterium operably linked to a structural gene encoding CAT. The examiner acknowledged that the chimeric gene and transformed host of Dzelzkalns differ from the claimed invention in that the former's structural gene encodes CAT rather than insecticidally active protein. However, the examiner pointed out, Sekar I, Sekar II, and Ganesan teach genes encoding insecticidally active proteins produced by *Bacillus*, and the advantages of expressing such genes in heterologous 18 hosts to obtain larger quantities of the protein. The examiner contended that it would have been obvious to one of ordinary skill in the art to substitute the *Bacillus* genes taught by Sekar I, Sekar II, and Ganesan for the CAT gene in the vectors of Dzelzkalns in order to obtain high level expression of the *Bacillus* genes in the transformed cyanobacteria. The examiner further contended that it would have been obvious to use cyanobacteria as heterologous hosts for expression of the claimed genes due to the ability of cyanobacteria to serve as transformed hosts for the

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expression of heterologous genes. In the absence of evidence to the contrary, the examiner contended, the invention as a whole was *prima facie* obvious.

Additional rejections were entered against various groups of dependent claims which we need not address here. All additional rejections were made in view of Dzelzkalns in combination with Sekar I, Sekar II, and Ganesan, and further in view of other references discussed in Part C above.

The Board affirmed the § 103 rejections, basically adopting the examiner's Answer as its opinion while adding a few comments. The legal conclusion of obviousness does not require absolute certainty, the Board added, but only a reasonable expectation of success, citing *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988). In view of the disclosures of the prior art, the Board concluded, one of ordinary skill in the art would have been motivated by a reasonable expectation of success to make the substitution suggested by the examiner.

## 2. *The § 112 Rejection*

The examiner also rejected claims 1-48 and 50-51 under 35 USC 112, first paragraph, on the ground that the disclosure was enabling only for claims limited in accordance with the specification as filed. Citing *Manual of Patent Examining Procedure* (MPEP) provisions 706.03(n) 19 and (z) 20 as support, the examiner took the position that undue experimentation would be required of the art worker to practice the claimed invention, in view of the unpredictability in the art, the breadth of the claims, the limited number of working examples and the limited guidance provided in the specification. With respect to unpredictability, the examiner stated that the cyanobacteria comprise a large and diverse group of photosynthetic bacteria including large numbers of species in some 150 different genera including *Synechocystis*, *Anacystis*, *Synechococcus*, *Agmenellum*, *Nostoc*, *Anabaena*, etc. The molecular biology of these organisms has only recently become the subject of intensive investigation and this work is limited to a few genera. Therefore the level of unpredictability regarding heterologous gene expression in this large, diverse and relatively poorly studied group of prokaryotes is high....

The Board affirmed, noting that "the limited guidance in the specification, considered in light of the relatively high degree of unpredictability in this particular art, would not have enabled one having ordinary skill in the art to practice the broad scope of the claimed invention without undue experimentation. *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970)."

## OPINION

### A. *Obviousness*

We first address whether the PTO erred in rejecting the claims on appeal as *prima facie* obvious within the meaning of 35 USC 103. Obviousness is a legal question which this court independently reviews, though based upon underlying factual findings which we review under the clearly erroneous standard. *In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990).

[1] Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. See *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *Id.*

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[2] We agree with appellants that the PTO has not established the *prima facie* obviousness of the claimed subject matter. The prior art simply does not disclose or suggest the expression in cyanobacteria of a chimeric gene encoding an insecticidally active protein, or convey to those of ordinary skill a reasonable expectation of success in doing so. More particularly, there is no suggestion in Dzelzkalns, the primary reference cited against all claims, of substituting in the disclosed plasmid a structural gene encoding *Bacillus* insecticidal proteins for the CAT gene utilized for selection purposes. The expression of antibiotic resistance-conferring genes in cyanobacteria, without more, does not render obvious the expression of unrelated genes in cyanobacteria for unrelated purposes.

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The PTO argues that the substitution of insecticidal *Bacillus* genes for CAT marker genes in cyanobacteria is suggested by the secondary references Sekar I, Sekar II, and Ganesan, which collectively disclose expression of genes encoding *Bacillus* insecticidal proteins in two species of host *Bacillus* bacteria ( *B. megaterium* and *B. subtilis* ) as well as in the bacterium *E. coli*. While these references disclose expression of *Bacillus* genes encoding insecticidal proteins in certain transformed *bacterial* hosts, nowhere do these references disclose or suggest expression of such genes in transformed *cyanobacterial* hosts.

To remedy this deficiency, the PTO emphasizes similarity between bacteria and cyanobacteria, namely, that these are both procaryotic organisms, and argues that this fact would suggest to those of ordinary skill the use of cyanobacteria as hosts for expression of the claimed chimeric genes. While it is true that bacteria and cyanobacteria are now both classified as procaryotes, that fact alone is not sufficient to motivate the art worker as the PTO contends. As the PTO concedes, cyanobacteria and bacteria are not identical; they are classified as two separate divisions of the kingdom Procaryotae. 21 Moreover, it is only in recent years that the biology of cyanobacteria has been clarified, as evidenced by references in the prior art to "blue-green algae." Such evidence of recent uncertainty regarding the biology of cyanobacteria tends to rebut, rather than support, the PTO's position that one would consider the cyanobacteria effectively interchangeable with bacteria as hosts for expression of the claimed gene.

At oral argument the PTO referred to additional secondary references, not cited against any independent claim (i.e., Friedberg, Miller, and Nierwicki-Bauer), which it contended disclose certain amino acid sequence homology between bacteria and cyanobacteria. The PTO argued that such homology is a further suggestion to one of ordinary skill to attempt the claimed invention. We disagree. As with the Dzelzkalns, Sekar I, Sekar II, and Ganesan references discussed above, none of these additional references disclose or suggest that cyanobacteria could serve as hosts for expression of genes encoding *Bacillus* insecticidal proteins. In fact, these additional references suggest as much about *differences* between cyanobacteria and bacteria as they do about similarities. For example, Nierwicki-Bauer reports that a certain nucleotide sequence (i.e., the -10 consensus sequence) in a particular cyanobacterium resembles an *E. coli* promoter, but that another nearby nucleotide sequence (the -35 region) does not. While Miller speaks of certain promoters of the bacteriophage Lambda that are recognized by both cyanobacterial and *E. coli* RNA polymerases, it also discloses that these promoters exhibited differing strengths when exposed to the different polymerases. Differing sensitivities of the respective polymerases to an inhibitor are also disclosed, suggesting differences in the structures of the initiation complexes.

The PTO asks us to agree that the prior art would lead those of ordinary skill to conclude that cyanobacteria are attractive hosts for expression of any and all heterologous genes. Again, we can not. The relevant prior art does indicate that cyanobacteria are attractive hosts for expression of both native and heterologous *genes involved in photosynthesis* (not surprisingly, for the capability of undergoing oxygenic photosynthesis is what makes the cyanobacteria unique among procaryotes). However, these references do not suggest that cyanobacteria would be equally attractive hosts for expression of *unrelated* heterologous genes, such as the claimed genes encoding *Bacillus* insecticidal proteins.

In *O'Farrell*, this court affirmed an obviousness rejection of a claim to a method for

producing a "predetermined protein in a stable form" in a transformed bacterial host. 853 F.2d at 895, 7 USPQ2d at 1674. The cited references included a prior art publication (the Polisky reference) whose three authors included two of the three coinventor-appellants. The main difference between the prior art and the claim at issue was that in Polisky, the heterologous gene was a gene for ribosomal RNA, while the claimed invention substituted a gene coding for a predetermined protein. *Id.* at 901, 7 USPQ2d at 1679. Although, as the appellants therein pointed out, the ribosomal RNA gene is not normally translated into protein, Polisky mentioned preliminary evidence that the transcript of the ribosomal RNA gene was translated into protein, and further predicted that if a gene coding for

a protein were to be substituted, extensive translation might result. *Id.* We thus affirmed, explaining that the prior art explicitly suggested the substitution that is the difference between the claimed invention and the prior art, and presented preliminary evidence suggesting that the [claimed] method could be used to make proteins.

....  
... Polisky contained detailed enabling methodology for practicing the claimed invention, a suggestion to modify the prior art to practice the claimed invention, and evidence suggesting that it would be successful.

*Id.* at 901-02, 7 USPQ2d at 1679-80.

In contrast with the situation in *O'Farrell*, the prior art in this case offers no suggestion, explicit or implicit, of the substitution that is the difference between the claimed invention and the prior art. Moreover, the "reasonable expectation of success" that was present in *O'Farrell* is not present here. Accordingly, we reverse the § 103 rejections.

## B. **Enablement**

[3] The first paragraph of 35 USC 112 requires, *inter alia*, that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without "undue experimentation." *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That *some* experimentation may be required is not fatal; the issue is whether the amount of experimentation required is "undue." *Id.* at 736-37, 8 USPQ2d at 1404. Enablement, like obviousness, is a question of law which we independently review, although based upon underlying factual findings which we review for clear error. *See id.* at 735, 8 USPQ2d at 1402.

In response to the § 112 rejection, appellants assert that their invention is "pioneering," and that this should entitle them to claims of broad scope. Narrower claims would provide no real protection, appellants argue, because the level of skill in this art is so high, art workers could easily avoid the claims. Given the disclosure in their specification, appellants contend that any skilled microbiologist could construct vectors and transform many different cyanobacteria, using a variety of promoters and *Bacillus* DNA, and could easily determine whether or not the active *Bacillus* protein was successfully expressed by the cyanobacteria.

The PTO made no finding on whether the claimed invention is indeed "pioneering," and we need not address the issue here. With the exception of claims 47 and 48, the claims rejected under § 112 are not limited to any particular genus or species of cyanobacteria. The PTO's position is that the cyanobacteria are a diverse and relatively poorly studied group of organisms, comprising some 150 different genera, and that heterologous gene expression in cyanobacteria is "unpredictable." Appellants have not effectively disputed these assertions.

Moreover, we note that only one particular species of cyanobacteria is employed in the working examples of appellants' specification, and only nine genera of cyanobacteria are mentioned in the entire document.

[4] Taking into account the relatively incomplete understanding of the biology of cyanobacteria as of appellants' filing date, as well as the limited disclosure by appellants of particular cyanobacterial genera operative in the claimed invention, we are not persuaded that the PTO erred in rejecting claims 1-46 and 50-51 under § 112, first paragraph. There is no reasonable correlation between the narrow disclosure in appellants' specification and the broad scope of protection sought in the claims encompassing gene expression in any and all cyanobacteria. *See In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970) (the first paragraph of § 112 requires that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification).

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22 Accordingly, we affirm the § 112 rejection as to those claims.

In so doing we do *not* imply that patent applicants in art areas currently denominated as "unpredictable" must never be allowed generic claims encompassing more than the particular species disclosed in their specification. It

is well settled that patent applicants are not required to disclose every species encompassed by their claims, even in an unpredictable art. *In re Angstadt*, 537 F.2d 498, 502-03, 190 USPQ 214, 218 (CCPA 1976). However, there must be sufficient disclosure, either through illustrative examples or terminology, 23 to teach those of ordinary skill how to make and how to use the invention as broadly as it is claimed. This means that the disclosure must adequately guide the art worker to determine, without undue experimentation, which species among all those encompassed by the claimed genus possess the disclosed utility. Where, as here, a claimed genus represents a diverse and relatively poorly understood group of microorganisms, the required level of disclosure will be greater than, for example, the disclosure of an invention involving a "predictable" factor such as a mechanical or electrical element. *See Fisher*, 427 F.2d at 839, 166 USPQ at 24. In this case, we agree with the PTO that appellants' limited disclosure does not enable one of ordinary skill to make and use the invention as now recited in claims 1-46 and 50-51 without undue experimentation.

Remaining dependent claim 47 recites a cyanobacterium which expresses the chimeric gene of claim 1, wherein the cyanobacterium is selected from among the genera *Anacystis* and *Synechocystis*. Claim 48, which depend from claim 47, is limited to the cyanobacterium *Synechocystis* 6803. The PTO did not separately address these claims, nor indicate why they should be treated in the same manner as the claims encompassing all types of cyanobacteria. Although these claims are not limited to expression of genes encoding particular *Bacillus* proteins, we note what appears to be an extensive understanding in the prior art of the numerous *Bacillus* proteins having toxicity to various insects. The rejection of claims 47-48 under § 112 will not be sustained.

## CONCLUSION

The rejection of claims 1-48 and 50-52 under 35 USC 103 is *reversed*. The rejection of claims 1-46 and 50-51 under 35 USC 112, first paragraph, is *affirmed* and the rejection of claims 47 and 48 thereunder is *reversed*.  
AFFIRMED-IN-PART, REVERSED-IN-PART

## Footnotes

Footnote 1. Basic vocabulary and techniques for gene cloning and expression have been described in *In re O'Farrell*, 853 F.2d 894, 895-99, 7 USPQ2d 1673, 1674-77 (Fed. Cir. 1988), and are not repeated here.

Footnote 2. All living cells can be classified into one of two broad groups, procaryotes and eucaryotes. The procaryotes comprise organisms formed of cells that do not have a distinct nucleus; their DNA floats throughout the cellular cytoplasm. In contrast, the cells of eucaryotic organisms such as man, other animals, plants, protozoa, algae and yeast have a distinct nucleus wherein their DNA resides.

Footnote 3. "Transformed" cyanobacteria are those that have successfully taken up the foreign *Bacillus* DNA such that the DNA information has become a permanent part of the host cyanobacteria, to be replicated as new cyanobacteria are generated.

Footnote 4. "Expression" of a gene refers to the production of the protein which the gene encodes; more specifically, it is the process of transferring information from a gene (which consists of DNA) via messenger RNA to ribosomes where a specific protein is made.

Footnote 5. In the context of the claimed invention, "selectable markers" or "marker genes" refer to antibiotic-resistance conferring DNA fragments, attached to the gene being expressed, which facilitate the selection of successfully transformed cyanobacteria.

Footnote 6. *Nucleic Acids Res.* 8917 (1984).

Footnote 7. Chloramphenicol is an antibiotic; CAT is an enzyme which destroys chloramphenicol and thus imparts resistance thereto.

Footnote 8. *Biochem. and Biophys. Res. Comm.* 748 (1986).

Footnote 9. *Gene* 151 (1985).

Footnote 10. *Mol. Gen. Genet.* 181 (1983).

Footnote 11. *Mol. Gen. Genet.* 505 (1986).

Footnote 12. *J. Bacteriology* 246 (1979).

Footnote 13. RNA polymerase, the enzyme responsible for making RNA from DNA, binds at specific nucleotide sequences (promoters) in front of genes in DNA, and then moves through the gene making an RNA molecule that includes the information contained in the gene. Initiation specificity is the ability of the RNA polymerase to initiate this process specifically at a site(s) on the DNA template.

Footnote 14. *Proc. Natl. Acad. Sci. USA* 5961 (1984).

Footnote 15. *Mol. Gen. Genet.* 185 (1986).

Footnote 16. *Gene* 211 (1984).

Footnote 17. *Gene* 289 (1984).

Footnote 18. Denotes different species or organism.

Footnote 19. MPEP 706.03(n), "Correspondence of Claim and Disclosure," provides in part:  
In chemical cases, a claim may be so broad as to not be supported by [the] disclosure, in which case it is rejected as unwarranted by the disclosure....

Footnote 20. MPEP 796.03(z), "Undue Breadth," provides in part:  
In applications directed to intentions in arts where the results are unpredictable, the disclosure of a single species usually does not provide an adequate basis to support generic claims. *In re Sol*, 1938 C.D. 723; 497 O.G. 546. This is because in arts such as chemistry it is not obvious from the disclosure of one species, what other species will work. *In re Dreshfield*, 1940 C.D. 351; 518 O.G. 255 gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result." ...

Footnote 21. *Stedman's Medical Dictionary* 1139 (24th ed. 1982) (definition of "Prokaryotae"). Prokaryotic organisms are commonly classified according to the following taxonomic hierarchy: Kingdom; Division; Class; Order; Family; Genus; Species. 3 *Berger's Manual of Systematic Bacteriology* 1601 (1989).

Footnote 22. The enablement rejection in this case was not based upon a post-filing date state of the art, as in *In re Hogan*, 559 F.2d 595, 605-07, 194 USPQ 527, 536-38 (CCPA 1977). See also *United States Steel Corp. v. Phillips Petroleum Co.*, 865 F.2d 1247, 1251, 9 USPQ2d 1461, 1464 (Fed. Cir. 1989) (citing *Hogan*); *Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1568-69, 15 USPQ2d 1039, 1047-48 (Fed. Cir. 1990) (directing district court, on remand, to consider effect of *Hogan* and *United States Steel* on the enablement analysis of *Fisher*), cert. dismissed, — U.S. —, 111 S. Ct. 1434 (1991). We therefore do not consider the effect of *Hogan* and its progeny on *Fisher*'s analysis of when an inventor should be allowed to "dominate the future patentable inventions of others." *Fisher*, 427 F.2d at 839, 166 USPQ at 24.

Footnote 23. The first paragraph of § 112 requires nothing more than *objective* enablement. *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). How such a teaching is set forth, either by the use of illustrative examples or by broad terminology, is irrelevant. *Id.*

## Dissenting Opinion Text

### Dissent By:

**Mayer, J., dissenting.**

An appeal is not a second opportunity to try a case or prosecute a patent application, and we should not allow parties to "undertake to retry the entire case on appeal." *Perini America, Inc. v. Paper Converting Machine Co.*, 832 F.2d 581, 584, 4 USPQ2d 1621, 1624 (Fed. Cir. 1987); *Eaton Corp. v. Appliance Valves Corp.*, 790 F.2d 874,

877, 229 USPQ 668, 671 (Fed. Cir. 1986). But that is precisely what the court has permitted here. The PTO conducted a thorough examination of the prior art surrounding this patent application and concluded the claims would have been obvious. The board's decision based on the examiner's answer which comprehensively explains the rejection is persuasive and shows how the evidence supports the legal conclusion that the claims would have been obvious. Yet, the court ignores all this and conducts its own examination, if you will, as though the examiner and board did not exist. Even if thought this opinion were more persuasive than the board's, I could not join it because it misperceives the role of the court.

The scope and content of the prior art, the similarity between the prior art and the claims, the level of ordinary skill in the art, and what the prior art teaches are all questions of fact. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966); *Jurgens v. McKasy*, 927 F.2d 1552, 1560, 18 USPQ2d 1031, 1037 (Fed. Cir. 1991). And "[w]here there are two permissible views of

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the evidence, the factfinder's choice between them cannot be clearly erroneous." *Anderson v. City of Bessemer City*, 470 U.S. 564, 574 (1985). The mere denomination of obviousness as a question of law does not give the court license to decide the factual matters afresh and ignore the requirement that they be respected unless clearly erroneous. *In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1935 (Fed. Cir. 1990); *In re Kulling*, 897 F.2d 1147, 1149, 14 USPQ2d 1056, 1057 (Fed. Cir. 1990). There may be more than one way to look at the prior art, but on this record we are bound by the PTO's interpretation of the evidence because it is not clearly erroneous and its conclusion is unassailable. I would affirm on that basis.

- End of Case -



**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

**Ex parte Levy (BdPatApp&Int) 17 USPQ2d 1461 Ex parte Levy****U.S. Patent and Trademark Office, Board of Patent Appeals and  
Interferences****17 USPQ2d 1461****Decided October 16, 1990  
No. 90-1864****Headnotes****PATENTS****1. Patentability/Validity - Anticipation - Identity of elements (§ 115.0704)**

Factual determination of anticipation requires disclosure in single reference of every element of claimed invention, and examiner must identify wherein each and every facet of claimed invention is disclosed in applied reference.

**2. Patentability/Validity - In general (§ 115.01)****Patentability/Validity - Anticipation - Prior art (§ 115.0703)**

Initial burden of establishing prima facie basis to deny patentability rests upon examiner; examiner, if relying upon theory of inherency, must provide basis in fact and/or technical reasoning to reasonably support determination that allegedly inherent characteristic necessarily flows from teachings of applied prior art.

**3. Patentability/Validity - Anticipation - Prior art (§ 115.0703)**

Examiner erred by rejecting claims for biaxially oriented catheter balloon as anticipated by prior art which does not disclose such biaxially oriented balloon and which has not been shown to be inherently biaxially oriented.

#### **4. Patentability/Validity - Obviousness - Relevant prior art - Particular inventions (§ 115.0903.03)**

Examiner erred by rejecting claims for biaxially oriented balloon catheter under 35 USC 103 based upon combined disclosure of two prior art references, one of which was relied upon solely for disclosed use of high viscosity polyethylene terephthalate tubing and the other which was presupposed by examiner to disclose biaxially oriented catheter balloon, since examiner has not established that resulting catheter balloon using high viscosity tubing is biaxially oriented.

### **Case History and Disposition:**

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**Application of Stanley B. Levy, serial no. 287,234, filed Dec. 21, 1988, which is a division of serial no. 914,108, filed Oct. 1, 1986, now Re. 32,983, granted July 4, 1989; and a reissue of serial no. 510,812, filed July 5, 1983, now patent no. 4,490,421, granted Dec. 25, 1984, for balloon and manufacture thereof. From examiner's rejection of claims 13 through 17 and 25 (James Seidleck, primary**

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**examiner), applicant appeals. Reversed.**

### **Attorneys:**

**Louis H. Rombach, Wilmington, Del., for appellant.**

### **Judge:**

**Before Steiner, Tarring, and J. Smith, examiners-in-chief.**

### **Opinion Text**

### **Opinion By:**

**Steiner, examiner-in-chief.**

This is an appeal from the final rejection of claims 13 through 17 and 25, which are all of the claims remaining in this application for reissue of U.S. Patent No. 4,490,421.

The subject matter on appeal is directed to a polymeric balloon exhibiting properties which enable its use as a

catheter balloon for medical dilation procedures, such as coronary angioplasty wherein a catheter with a balloon at a distal end thereof is inserted into coronary arteries and inflated. The balloon must be capable of exerting sufficient pressure to dilate stenotic lesions without rupture of the balloon.

Claims 13 and 25, the only independent claims on appeal, read as follows:

13. *High molecular weight, biaxially oriented, flexible polymeric balloon having a wall tensile strength of at least 31,714 psi (218.86 MPa).*

25. *High molecular weight, biaxially oriented, flexible polyethylene terephthalate dilatation catheter balloon.*

The references relied upon by the examiner are:

Wyeth et al. (Wyeth)	3,733,309	May 15, 1973
Schjeldahl et al. (Schjeldahl '989)	4,413,989	Nov. 8, 1983 1
Schjeldahl et al. (Schjeldahl '000)	4,456,000	June 26, 1984 2

Claims 13, 14, 16, 17 and 25 stand rejected under 35 U.S.C. 102 as anticipated by Schjeldahl. Claims 13 through 17 stand rejected under 35 U.S.C. 103 based upon "Schjeldahl et al in view of Wyeth as set forth in the Final Rejection" (paragraph bridging pages 3 and 4 of the Answer). We reverse each rejection.

### ***The Rejection of Claims 13, 14, 16, 17 and 25 Under 35 U.S.C. §102.***

[1] The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention. *In re Spada*, — F.2d —, 15 USPQ2d 1655 (Fed. Cir. 1990); *In re Bond*, — F.2d —, 15 USPQ2d 1566 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Alco Standard Corp. v. TVA*, 808 F.2d 1490, 1 USPQ2d 1337 (Fed. Cir. 1986); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978); *In re Arkley*, 455 F.2d 586, 172 USPQ 524 (CCPA 1972). Moreover, it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Each of the independent claims on appeal defines a polymeric balloon which is "biaxially oriented." Ergo, in order to establish a *prima facie* basis to defeat the patentability of independent claims 13 and 25 under 35 U.S.C. §102, the examiner is obliged to point out where Schjeldahl discloses a *biaxially oriented* polymeric balloon. The tenor of the final rejection and Answer presupposes that Schjeldahl discloses a biaxially oriented polymeric balloon.

See, for example, page 5 of the Final Rejection wherein the examiner states

he reference clearly teaches a biaxially oriented balloon catheter, and states that it is made by injection blow molding.

See, also, page 5 of the Answer wherein the examiner states

rguments that the references don't disclose a biaxially oriented PET (polyethylene terephthalate) balloon catheter is contrary to what is *clearly stated* in the references (emphasis supplied).

The examiner does not point to, and we do not find, any express disclosure in Schjeldahl of a biaxially oriented polymeric balloon.

It would appear that the relevant evulgations in Schjeldahl which may have led the examiner to his determination are:

(a) an expander 3 formed *from* a thin, flexible inelastic, high tensile strength, *biaxially oriented* synthetic plastic material

(column 2 of Schjeldahl '989, lines 63 through 65, emphasis supplied);

- (b) The expander 30 is preferably formed *from* a suitable synthetic plastic material, such as *biaxially oriented polypropylene*, *by an injection blow molding operation* and, as such, is substantially inelastic in both the axial and radial directions and may, for example, have a finished wall thickness in the range of from 0.005 to 0.200 millimeters, 0.025 millimeters being typical (column 6 of Schjeldahl '989, lines 45 through 52, emphasis supplied);
- (c) It has been found that an expander of the above-dimensional characteristics can withstand internal inflation pressure in excess of 7 atmospheres without fear of rupture (column 6 of Schjeldahl '989, lines 62 through 65);
- (d) injection blow molding step used to form the expander 30 (column 8, lines 16 and 17);
- (e) the expander 30 is formed *from a biaxially oriented* thin plastic material capable of withstanding relatively high internal pressures without rupture and without exceeding the elastic limit for the material itself (column 10 of Schjeldahl '989, lines 32 through 36, emphasis supplied);
- (f) the expander 82 is preferably formed *from* a suitable synthetic plastic material such as *biaxially oriented polypropylene* or *biaxially oriented polyethylene terephthalate by an injection molding operation* and, as such, is substantially inelastic in both the axial and radial direction (column 12 of Schjeldahl '989, lines 22 through 37, emphasis supplied); and
- (g) Apparatus as in claim 1 wherein said non-elastic expander member comprises a longitudinally extending thin, flexible, tubular element *formed from a biaxially oriented* synthetic plastic material surrounding said outer tubular member with opposed ends thereof secured to said outer tubular member at spaced apart locations proximate said distal end thereof (claim 8 of Schjeldahl '989, emphasis supplied).

These excerpts do not justify the determination that Schjeldahl discloses a biaxially oriented polymeric balloon. According to Schjeldahl, the *starting* material is a biaxially oriented synthetic plastic material, such as polyethylene terephthalate. The *final article*, *i.e.*, the expander or catheter balloon, is *not characterized as biaxially oriented*. Moreover, it would appear to be *undisputed* that the *only* method disclosed by Schjeldahl for transforming the biaxially oriented *starting* plastic into the *final* catheter balloon, *i.e.*, injection blow molding, is *not* capable of producing a biaxially oriented catheter balloon. In fact, it is *undisputed* that injection blow molding would *destroy* the biaxial orientation of the plastic starting material. We refer to the Belcher affidavits, Exhibits V, VI and VIII, 4 which factually set forth the differences between "injection blow molding" and "injection stretch blow molding," and support the conclusion that the "injection blow molding" process disclosed by Schjeldahl could not possibly produce a biaxially oriented polymeric balloon. 5

Indeed, the examiner agrees with appellant's position that injection blow molding could *not* produce a biaxially oriented balloon. See, for example, page 5 of the Final Rejection wherein the examiner states: statements that injection blow molding without stretching will not produce a biaxially oriented article are *true* ... (emphasis supplied).

The examiner goes on, in the same sentence, to state:

but since the reference produces a biaxially oriented article, clearly a stretching step must be used.

Again, on page 5 of the Answer, the examiner states:

Since Schjeldahl et al produces a biaxially oriented article it follows that a stretching step must be used in the injection blow molding process.

The inescapable facts are that Schjeldahl does not disclose a biaxially oriented catheter balloon and does not mention a stretching step.

[2] The examiner also relies upon the theory that Schjeldahl's catheter balloon is inherently biaxially oriented. On page 4 of the Answer, the examiner points out that inasmuch as the Patent and Trademark Office does not have the requisite laboratory equipment for testing, the burden shifts to appellant. However, the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests

upon the examiner. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); *Hansgirg v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939). In our opinion, the examiner has not discharged that initial burden.

Schjeldahl does not provide any working example revealing the process conditions employed to produce the catheter balloon. We have *only* a general invitation to employ "injection blow molding." As previously discussed, it is undisputed that injection blow molding would *not* have produced a biaxially oriented balloon and would have destroyed the biaxially orientation of a polymeric starting material.

Schjeldahl does not disclose any particular tensile strength of the catheter balloon. We do not find sufficient factual basis or cogent scientific reasoning to support the conclusion that Schjeldahl's disclosure with respect to the ability of the catheter balloon to "withstand an internal inflation pressure in excess of 7 atmospheres without fear of rupture" (column 6 of Schjeldahl '989, lines 63 through 65) *necessarily* means that the catheter balloon is biaxially oriented. According to the membrane equation calculations reported in Levy's declaration (Exhibit IV), Schjeldahl's balloon could not possibly exhibit the tensile characteristics of a biaxially oriented balloon. Levy's calculations are *inconsistent* with those of Pinchuk (Exhibit III). Suffice it to say, the conflicting calculations taint the factual determination of inherency with impermissible conjecture. Indeed, the examiner, in the paragraph bridging pages 4 and 5 of the Answer, states that

the membrane equation used to determine the tensil [sic, tensile] strength can be manipulated to produce any desired value, and thus is misleading.

Nevertheless, the examiner goes on to favor Pinchuk's calculations by stating in that same paragraph that certainly use of the typically used wall thickness disclosed in Schjeldahl et al with the average radius, as done in the Pinchuk Declaration would be reasonable.

As noted above, the conflicting results obtained by applying the membrane equation, and the examiner's acknowledgment that that equation "can be manipulated to produce any desired value," underscore the speculative nature upon which the determination of inherency rests.

We do not find sufficient cogent technical reasoning and/or objective evidence to support the conclusion that Schjeldahl's characterization of the catheter balloon as inelastic in the axial and radial direction *necessarily* means that the catheter balloon is biaxially oriented. The characteristic "inelastic," as employed by Schjeldahl, apparently means that the catheter balloon will expand to a preformed diameter to enable precise measurement of the pressures exerted on the inner wall of the artery during the dilation procedure (column 4 of Schjeldahl '989, lines 12 through 17).

[3] In summary, Schjeldahl does not disclose a biaxially oriented catheter balloon. We do not find a sufficient basis to support the determination that Schjeldahl's balloon is *inherently* (necessarily) biaxially oriented. *In re King, supra*; *W.L. Gore & Associates, Inc. v. Garlock, Inc., supra*; *In re Oelrich, supra*; *In re Wilding, supra*; *Hansgirg v. Kemmer, supra*. Accordingly, the examiner's rejection of claims 13, 14, 16, 17 and 25, under 35 U.S.C. §102 as anticipated by Schjeldahl is reversed. 6

*The Rejection of Claims 13 through 17 under 35 U.S.C. §103 Based upon the Combined Disclosures of Schjeldahl and Wyeth.*

Wyeth is directed to producing high strength biaxially oriented polyethylene terephthalate beverage containers. The disclosed method involves stretching polyethylene terephthalate having a relatively high inherent viscosity; e.g., at least about 0.85.

It is apparent from the Final Rejection and Answer that the examiner's rejection of the appealed claims under 35 U.S.C. 103 is *not* predicated upon the theory that one having ordinary skill in the art would have been led to employ Wyeth's technique to produce a biaxially oriented balloon for use in Schjeldahl's catheter. Instead, the examiner presupposes that Schjeldahl discloses a biaxially oriented catheter balloon. The examiner relies upon Wyeth *solely* for the disclosed use of high viscosity polyethylene terephthalate tubing. We refer to page 6 of the Answer, first complete paragraph, wherein the examiner explains the rejection by stating:

Wyeth et al is not being combined with Schjeldahl et al, but merely shows the claimed high viscosity PET (polyethylene terephthalate) and supports the examiners [sic, examiner's] inherency arguments. 7 ... The examiner is not substituting the process of Wyeth et al into Schjeldahl et al since both disclose the same process. 8 Arguments that Wyeth et al can't be scaled down are irrelevant since the examiner is not seeking to scale down that reference to produce the claimed article.

[4] We have already concluded that the examiner factually erred in determining that Schjeldahl expressly or inherently discloses a biaxially oriented catheter balloon. Assuming, *arguendo*, the examiner correctly concluded that one having ordinary skill in the art would have been led to employ a high viscosity polyethylene terephthalate tubing in producing Schjeldahl's catheter balloon, the rejection under 35 U.S.C. §103 must fall because the examiner has not established that the resulting catheter balloon is biaxially oriented. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Inasmuch as the examiner's rejection under 35 U.S.C. §103 is not predicated upon the theory that one having ordinary skill in the art would have been led to employ a conventional stretch blow molding technique, such as that disclosed by Wyeth, to produce Schjeldahl's catheter balloon, the motivation for such a combination is an issue which was not crystallized on appeal and was not confronted by appellant. However, in view of the examiner's gratuitous statement in the paragraph bridging pages 5 and 6 of the Answer, 9 we are constrained to address that issue.

There appears to be no dispute that one having ordinary skill in the art would have recognized the desirability of producing a biaxially oriented balloon for use in Schjeldahl's catheter, since biaxially oriented materials were known to exhibit high tensile strengths. The thrust of the evidence relied upon by the examiner is that one having ordinary skill in the art would have simply resorted to a conventional stretch molding technique to produce a biaxially oriented balloon for use in Schjeldahl's catheter, specifically, *the technique employed by Wyeth to produce a beverage container*. See paragraph 4 of the Rydell affidavit executed April 25, 1988 and offered in support of the protest in parent application Serial No. 914,108, paragraph 5 of the Pinchuk affidavit (Exhibit III), and paragraphs 4 and 5 of the Kaufman affidavit (Exhibit XII). Interestingly enough, *Wyeth disagrees*. See page 5 of Wyeth's declaration (Exhibit XI). Wyeth points out various differences between the PET bottles produced by his disclosed process and the requirements of a catheter balloon, and then concludes that his process could *not* be used to produce a catheter balloon of the type disclosed by Levy.

We are persuaded by Belcher's affidavits and Wyeth's declaration, notwithstanding the affidavits of Rydell, Pinchuk and Kaufman, 10 that the known processes for producing

biaxially oriented beverage containers, such as that disclosed by Wyeth, could not have been simply scaled down to produce a biaxially oriented catheter balloon for use in medical dilation procedures without the exercise of inventive skill. 11 Based upon the record before us, it would appear unrealistic to conclude that one having ordinary skill in the art would have been led to employ Wyeth's technique, which is designed to produce beverage containers, to produce Schjeldahl's catheter balloon, motivated by a *reasonable expectation* of obtaining a  polymeric catheter balloon. *In re O'Farrell*, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988). The rejection under 35 U.S.C. §103 is also reversed.

*REVERSED.*

## Footnotes

Footnote 1. Each of the Schjeldahl references contains essentially the same relevant disclosure. Accordingly, unless otherwise indicated, we have referred to these references collectively as "Schjeldahl," consistent with the approach adopted by both appellant and the examiner.

Footnote 2. See footnote 1.

Footnote 3. Schjeldahl characterizes the catheter balloon as an expander.

Footnote 4. Unless otherwise indicated, all exhibits mentioned are the exhibits to appellant's Brief.

Footnote 5. We recognize that a high burden of proof is required to demonstrate the inoperability of a United States patent. *In re Weber*, 405 F.2d 1403, 160 USPQ 549 (CCPA 1969); *In re Michalek*, 162 F.2d 229, 74 USPQ 107 (CCPA 1947). However, as noted above, Schjeldahl does not disclose a catheter balloon made of a biaxially oriented plastic. Therefore, appellant's evidence is not an attack on the operability of Schjeldahl, but quite relevant to the issue of inherency, *i.e.*, whether the catheter balloon disclosed by Schjeldahl is inherently biaxially oriented.

Footnote 6. There is evidence of record that Dupont, the assignee of the application, furnished biaxially oriented polyethylene terephthalate to Schjeldahl when he informed Dupont personnel that he required a thin, high strength polymeric film having a tensile strength in the range of 20,000-40,000 psi. See the Schjeldahl affidavit (Exhibit VIII) and the Dengler declaration executed on May 21, 1988 and appended to the protest submitted in parent application Serial No. 914,108. Such facts are not inconsistent with our determination that Schjeldahl does not disclose a biaxially oriented polyethylene terephthalate catheter balloon. The Rydell affidavit appended to the protest in the parent application does not persuade us that Schjeldahl expressly or inherently discloses a biaxially oriented polymeric catheter balloon. See Belcher's affidavit (Exhibit VI).

Footnote 7. Actually, according to the Final Rejection which is incorporated in the Answer, it is the Examiner's position that it would be *prima facie* obvious to use the high viscosity polyethylene terephthalate of Wyeth in Schjeldahl et al to produce the claimed product (page 4, the only complete paragraph).

Footnote 8. It is apparent from our reversal of the examiner's rejection under 35 U.S.C. §102 that, in our opinion, Schjeldahl discloses neither a biaxially oriented catheter balloon nor a molding process which involves stretching.

Footnote 9. The noted statement provides:

Certainly in the least there was an *invitation* to make a biaxially oriented catheter balloon at the time of the Schjeldahl et al invention. Additionally injection stretch blow molding to produce biaxially oriented articles was well known at the time of the Schjeldahl et al invention (emphasis supplied).

Footnote 10. We agree with appellant that the credentials of Belcher and Wyeth in the relevant art appear more impressive than those of protestor's experts. According to the affidavit appearing as Appendix V, Belcher authored the chapter called "Blow Molding of Polymers" for the fifth edition of the Plastic Engineering Handbook of the Society of Plastics Industry. In addition, Belcher authored two chapters, one on "injection blow molding" and one on "stretch blow molding" for the Blow Molding Handbook of the Society of Plastics and Engineers. We consider Wyeth's opinion with respect to the capabilities of his own invention entitled to greater weight than the opinions of Rydell, Pinchuk and Kaufman.

Footnote 11. We find it somewhat unrealistic in light of the apparent disparities in size and function, Belcher's affidavits and Wyeth's declaration, that Pinchuk and Kaufman equate beverage bottles to catheter balloons. See paragraph 10 of the Pinchuk affidavit (Exhibit III), wherein it is stated  
s a blow molded polymeric article, a bottle and a catheter balloon are equivalent.

See, also, paragraph 4 of the Kaufman affidavit (Exhibit XII), wherein it is stated that anyone with ordinary skill in the plastics art would know how to make a biaxially oriented PET balloon; it would be similar to making a biaxially oriented PET bottle because both catheter balloons and bottles are equivalent structures - they are both fluid containers.

**- End of Case -**



**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

**In re Fine (CA FC) 5 USPQ2d 1596 In re Fine****U.S. Court of Appeals Federal Circuit  
5 USPQ2d 1596****Decided January 26, 1988  
No. 87-1319****Headnotes****PATENTS****1. Patentability/Validity -- Obviousness -- Evidence of (§ 115.0903)**

Patent and Trademark Office improperly rejected claimed invention for obviousness since nothing in cited references, either alone or in combination, suggests or teaches claimed invention, since there is consequently no support for PTO's conclusion that substitution of one type of detector for another in prior art system, resulting in claimed invention, would have been obvious, and since PTO therefore failed to satisfy its burden of establishing prima facie case of obviousness by showing some objective teaching or generally available knowledge that would lead one skilled in art to combine teachings of existing references.

**2. Patentability/Validity -- Obviousness -- In general (§ 115.0901)**

Obviousness is tested by what combined teachings of prior art references would have suggested to those of ordinary skill in art, not by whether particular combination of elements from such references might have been "obvious to try."

**3. Patentability/Validity -- Obviousness -- Evidence of (§ 115.0903)**

Patent and Trademark Office erred, in rejecting as obvious system for detecting and measuring minute quantities of nitrogen compounds, by failing to recognize that appealed claims can be distinguished over combination of prior art references, in view of evidence demonstrating that prior art does not teach claimed temperature range, despite some overlap of preferred temperature ranges for claimed invention and prior art, since purposes of preferred temperature ranges are different and overlap is mere happenstance.

#### **4. Patentability/Validity -- Obviousness -- In general (§ 115.0901)**

Dependent claims are non-obvious under 35 USC 103 if claims from which they depend are non-obvious.

#### **Case History and Disposition:**

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#### **Appeal from the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences.**

**Application for patent by David H. Fine, Serial No. 512,374. From decision of Board of Patent Appeals and Interferences affirming rejection of application, applicant appeals. Reversed; Smith, circuit judge, dissenting with opinion.**

#### **Attorneys:**

**Morris Nelson and Darby & Darby, New York, N.Y., (Beverly B. Goodwin with them on the brief) for appellant.**

**Lee E. Barrett, associate solicitor, Arlington, Va., (Joseph F. Nakamura, solicitor, and Fred E. McKelvey, deputy solicitor, with him on the brief) for appellee.**

#### **Judge:**

**Before Friedman, Smith, and Mayer, circuit judges.**

#### **Opinion Text**

#### **Opinion By:**

**Mayer, J.**

David H. Fine appeals from a decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office (Board) affirming the rejection of certain claims of his application, Serial No. 512,374, and concluding that his invention would have been obvious to one of ordinary skill in the art and was therefore

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unpatentable under 35 U.S.C. §103. We reverse.

## Background

### A. The Invention.

The invention claimed is a system for detecting and measuring minute quantities of nitrogen compounds. According to Fine, the system has the ability to detect the presence of nitrogen compounds in quantities as minute as one part in one billion, and is an effective means to detect drugs and explosives, which emanate nitrogen compound vapors even when they are concealed in luggage and closed containers.

The claimed invention has three major components: (1) a gas chromatograph which separates a gaseous sample into its constituent parts; (2) a converter which converts the nitrogen compound effluent output of the chromatograph into nitric oxide in a hot, oxygen-rich environment; and (3) a detector for measuring the level of nitric oxide. The claimed invention's sensitivity is achieved by combining nitric oxide with ozone to produce nitrogen dioxide which concurrently causes a detectable luminescence. The luminescence, which is measured by a visual detector, shows the level of nitric oxide which in turn is a measure of nitrogen compounds found in the sample.

The appealed claims were rejected by the Patent and Trademark Office (PTO) under 35 U.S.C. §103. Claims 60, 63, 77 and 80 were rejected as unpatentable over Eads, Patent No. 3,650,696 (Eads) in view of Warnick, et al., Patent No. 3,746,513 (Warnick). Claims 62, 68, 69, 79, 85 and 86 were rejected as unpatentable over Eads and Warnick in view of Glass, et al., Patent No. 3,207,585 (Glass).

### B. The Prior Art.

#### 1. Eads Patent.

Eads discloses a method for separating, identifying and quantitatively monitoring sulfur compounds. The Eads system is used primarily in "air pollution control work in the scientific characterization of odors from sulfur compounds."

The problem addressed by Eads is the tendency of sulfur compounds "to adhere to or react with the surface materials of the sampling and analytical equipment, and/or react with the liquid or gaseous materials in the equipment." Because of this, the accura

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cy of measurement is impaired. To solve the problem, the Eads system collects an air sample containing sulfur compounds in a sulfur-free methanol solution. The liquid is inserted into a gas chromatograph which separates the various sulfur compounds. The compounds are next sent through a pyrolysis furnace where they are oxidized to form sulfur dioxide. Finally, the sulfur dioxide passes through a measuring device called a microcoulometer which uses titration cells to calculate the concentration of sulfur compounds in the sample.

#### 2. Warnick Patent.

Warnick is directed to a means for detecting the quantity of pollutants in the atmosphere. By measuring the chemiluminescence of the reaction between nitric oxide and ozone, the Warnick device can detect the concentration of nitric oxide in a sample gaseous mixture.

Warnick calls for "continuously flowing" a sample gaseous mixture and a reactant containing ozone into a reaction chamber. The chemiluminescence from the resulting reaction is transmitted through a light-transmitting element to produce continuous readouts of the total amount of nitric oxide present in the sample.

#### 3. Glass Patent.

The invention disclosed in Glass is a device for "completely burning a measured amount of a substance and analyzing the combustion products." A fixed amount of a liquid petroleum sample and oxygen are supplied to a flame. The flame is then spark-ignited, causing the sample to burn. The resulting combustion products are then collected and measured, and from this measurement the hydrogen concentration in the sample is computed.

### **C. The Rejection .**

The Examiner rejected claims 60, 63, 77 and 80 because "substitution of the [nitric oxide] detector of Warnick for the sulfur detector of Eads would be an obvious consideration if interested in nitrogen compounds, and would yield the claimed invention." He further asserted that "Eads teaches the [claimed] combination of chromatograph, combustion, and detection, in that order. . . . Substitution of detectors to measure any component of interest is well within the skill of the art." In rejecting claims 62, 68, 69, 79, 85 and 86, the Examiner said, "Glass et al. teach a flame conversion means followed by a detector, and substitution of the flame conversion means of Glass et al. for the furnace of Eads would be an obvious equivalent and would yield the claimed invention." The Board affirmed the Examiner's rejection.

## **Discussion**

### **A. Standard of Review .**

Obviousness under 35 U.S.C. §103 is " 'a legal conclusion based on factual evidence.' " *Stratoflex, Inc. v. Aeroquip Corp.* , 713 F.2d 1530, F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983) (quoting *Stevenson v. Int'l Trade Comm'n* , 612 F.2d 546, 549, 204 USPQ 276, 279 (CCPA 1979) ). Therefore, an obviousness determination is not reviewed under the clearly erroneous standard applicable to fact findings, *Raytheon Co. v. Roper Corp.* , 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Cir. 1983); it is "reviewed for correctness or error as a matter of law." *In re De Blauwe* , 736 F.2d 699, 703, 222 USPQ 191, 195 (Fed. Cir. 1984).

To reach a proper conclusion under §103, the decisionmaker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of *all* the evidence, the decisionmaker must then determine whether . . . the claimed invention as a whole would have been obvious at *that* time to *that* person. 35 U.S.C. §103. The answer to that question partakes more of the nature of law than of fact, for it is an ultimate conclusion based on a foundation formed of all the probative facts.

*Panduit Corp. v. Dennison Mfg. Co.* , 810 F.2d 1561, 1566, 1 USPQ2d 1593, 1595-96 (Fed. Cir. 1987).

### **B. Prima Facie Obviousness .**

Fine says the PTO has not established a *prima facie* case of obviousness. He contends the references applied by the Board and Examiner were improperly combined, using hindsight reconstruction, without evidence to support the combination and in the face of contrary teachings in the prior art. He argues that the appealed claims were rejected because the PTO thought it would have been "obvious to try" the claimed invention, an unacceptable basis for rejection.

[1] We agree. The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. See *In re Piasecki* , 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-87 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Lalu* , 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984); *see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* ,

the cited references, either alone or in combination, suggesting or teaching Fine's invention.

The primary basis for the Board's affirmance of the Examiner's rejection was that it would have been obvious to substitute the Warnick nitric oxide detector for the Eads sulfur dioxide detector in the Eads system. The Board reiterated the Examiner's bald assertion that "substitution of one type of detector for another in the system of Eads would have been within the skill of the art," but neither of them offered any support for or explanation of this conclusion.

Eads is limited to the analysis of sulfur compounds. The particular problem addressed there is the difficulty of obtaining precise measurements of sulfur compounds because of the tendency of sulfur dioxide to adhere to or react with the sampling analytic equipment or the liquid or gaseous materials in the equipment. It solves this problem by suggesting that the gaseous sample containing sulfur compounds be absorbed into sulfur-free methanol and then inserted into a gas chromatograph to separate the sulfur compounds.

There is no suggestion in Eads, which focuses on the unique difficulties inherent in the measurement of sulfur, to use that arrangement to detect nitrogen compounds. In fact, Eads says that the presence of nitrogen is undesirable because the concentration of the titration cell components in the sulfur detector is adversely affected by substantial amounts of nitrogen compounds in the sample. So, instead of suggesting that the system be used to detect nitrogen compounds, Eads deliberately seeks to avoid them; it warns against rather than teaches Fine's invention. *See W. L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983) (error to find obviousness where references "diverge from and teach away from the invention at hand"). In the face of this, one skilled in the art would not be expected to combine a nitrogen-related detector with the Eads system. Accordingly, there is no suggestion to combine Eads and Warnick.

Likewise, the teachings of Warnick are inconsistent with the claimed invention, to some extent. The Warnick claims are directed to a gas stream from engine exhaust "continuously flowing the gaseous mixtures into the reaction chamber" to obtain "continuous readouts" of the amount of nitric oxide in the sample. The other words, it contemplates measuring the total amount of nitric oxide in a continuously flowing gaseous mixture of unseparated nitrogen constituents. By contrast, in Fine each nitrogen compound constituent of the gaseous sample is retained in the Chromatograph for an individual time period so that each exists in discrete, time-separated pulses. \* By this process, each constituent may be both identified by its position in time sequence, and measured. The claimed system, therefore, diverges from Warnick and teaches advantages not appreciated or contemplated by it.

Because neither Warnick nor Eads, alone or in combination, suggests the claimed invention, the Board erred in affirming the Examiner's conclusion that it would have been obvious to substitute the Warnick nitric oxide detector for the Eads sulfur dioxide detector in the Eads system. *ACS Hosp. Sys.*, 732 F.2d at 1575-77, 221 USPQ at 931-33. The Eads and Warnick references disclose, at most, that one skilled in the art might find it obvious to try the claimed invention. But whether a particular combination might be "obvious to try" is not a legitimate test of patentability. *In re Geiger*, 815 F.2d 868, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *In re Goodwin*, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978).

[2] Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* Here, the prior art contains none.

Instead, the Examiner relies on hindsight in reaching his obviousness determination.

But this court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect

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of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W. L. Gore*, 721 F.2d at 1553, 220 USPQ at 312-13. It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

### **C. Advantage Not Appreciated by the Prior Art .**

[3] The Board erred not only in improperly combining the Eads and Warnick references but also in failing to appreciate that the appealed claims can be distinguished over that combination. A material limitation of the claimed system is that the conversion to nitric oxide occur in the range of 600°C to 1700°C. The purpose of this limitation is to prevent nitrogen from other sources, such as the air, from being converted to nitric oxide and thereby distorting the measurement of nitric oxide derived from the nitrogen compounds of the sample.

The claimed nitric oxide conversion temperature is not disclosed in Warnick. Although Eads describes a preferred temperature of 675°C to 725°C, the purpose of this range is different from that of Fine. Eads requires the 675°C to 725°C range because it affords a temperature low enough to avoid formation of unwanted sulfur trioxide, yet high enough to avoid formation of unwanted sulfides. Fine's temperature range, in contrast, does not seek to avoid the formation of sulfur compounds or even nitrogen compounds. It enables the system to break down the nitrogen compounds of the sample while avoiding the destruction of background nitrogen gas. There is a partial overlap, of course, but this is mere happenstance. Because the purposes of the two temperature ranges are entirely unrelated, Eads does not teach use of the claimed range. *See In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278. The Board erred by concluding otherwise.

### **D. Unexpected Results .**

Because we reverse for failure to establish a *prima facie* case of obviousness, we need not reach Fine's contention that the Board failed to accord proper weight to the objective evidence of unexpected superior results. *Id.*

### **E. The "Flame" Claims .**

[4] Claims 62, 68, 69, 79, 85 and 86 relate to the oxygen-rich flame conversion means of the claimed invention. These "flame" claims depend from either apparatus claim 60 or method claim 77. Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious. *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987); *In re Abele*, 684 F.2d 902, 910, 214 USPQ 682, 689 (CCPA 1982); *see also In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). In view of our conclusion that claims 60 and 77 are nonobvious, the dependent "flame" claims are also patentable.

### **Conclusion**

The Board's decision affirming the Examiner's rejection of claims 60, 62, 63, 68, 69, 77, 79, 80, 85 and 86 of Fine's application as unpatentable over the prior art under 35 U.S.C. §103 is *REVERSED* .

### **Footnotes**

Footnote \*. The Solicitor argues that the contents of Attachment C of Fine's brief were not before the Board and may not properly be considered here. However, we need not rely on Attachment C. It is merely illustrative of the qualitative separation of nitrogen compounds which occurs in Fine's system. The fact that the various constituents exit at discrete intervals is shown by the specification which was before the Board and which may appropriately be

considered on appeal. *See, e.g., Astra-Sjuco, A.B. v. United States Int'l Trade Comm'n* , 629 F.2d 682, 686, 207 USPQ 1, 5 (CCPA 1980) (claims must be construed in light of specification).

### Dissenting Opinion Text

**Dissent By:**

**Smith, circuit judge, dissenting.**

I respectfully dissent. I am of the firm belief that the prior art references, relied upon by the PTO to establish its prima facie case of obviousness, in combination teach and suggest Fine's invention to one skilled in the art. Also, I firmly believe that Fine failed to rebut the PTO's prima facie case. On this basis, I would affirm the board's determination sustaining the examiner's rejection, pursuant to 35 U.S.C. §103, of Fine's claims on appeal before this court.

**- End of Case -**



**FULL TEXT OF CASES (USPQ2D)****All Other Cases****In re Rijckaert (CA FC) 28 USPQ2d 1955 In re Rijckaert****U.S. Court of Appeals Federal Circuit  
28 USPQ2d 1955****Decided November 23, 1993  
No. 93-1206****Headnotes****PATENTS****1. Patentability/Validity -- Obviousness -- Relevant prior art -- Particular inventions (§ 115.0903.03)**

Board of Patent Appeals and Interferences erred by affirming rejection, on grounds of obviousness, of claims for apparatus to record and reproduce electric signal on magnetic record carrier, since references relied upon to reject claims do not provide basis for *prima facie* determination of obviousness, in that prior art relied upon, either individually or when combined, does not disclose, suggest, or render obvious claimed invention, and since applicant's burden to rebut rejection of obviousness does not arise until *prima facie* case has been established.

**Case History and Disposition:**

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**Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.**

**Application for patent, serial no. 07/345,396, filed by Albert M.A. Rijckaert and Joannes A.E. Van Der Kop. From decision affirming final rejection of claims, applicants appeal. Reversed.**

**Attorneys:**

**Edward W. Goodman (Algy Tamoshunas, with him on brief), Tarrytown, N.Y., for appellant.**

**Lee E. Barrett, associate solicitor, PTO (Fred E. McKelvey, solicitor, with him on brief), for appellee.**

**Judge:**

**Before Lay, senior circuit judge (Eighth Circuit, sitting by designation), and Mayer and Lourie, circuit judges.**

**Opinion Text**

**Opinion By:**

**Lourie, J.**

Albert Rijckaert and Joannes van der Kop ("Rijckaert") appeal from the decision of the United States Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences affirming the final rejection of claims 5-12, all of the pending claims in patent application serial no. 07/345,396, as being unpatentable under 35 U.S.C. Section 103 (1988). Because the references relied upon to reject the claims do not provide the basis for a *prima facie* determination that the claimed invention would have been obvious, we reverse.

**BACKGROUND**

The patent application at issue relates to an apparatus for recording and reproducing an electric signal on a magnetic record carrier. Independent claim 11 is drawn to a recording apparatus and it specifies a relationship between time expansion or compression and three variables a, n, and M. Claim 11 reads, in pertinent part:

11. An apparatus for recording an electric signal on a magnetic record carrier in tracks which are inclined relative to the longitudinal direction of said record carrier, comprising: . . .

. . . . [a] time-base correction circuit provid [ing] a time expansion or time compression of the signal blocks by a factor of  $a^n/(180*(M+1))$ , where a is the

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wrapping angle of the record carrier around the head drum and differs from 180 degrees, n is the number of head pairs, and M is the number of times within a specific time interval that a head pair which comes in contact with the record carrier during said time interval does not record a signal on the record carrier, said time interval being defined by those instants at which two consecutive track pairs are recorded by one or two head pairs.

Independent claim 12 is drawn to an apparatus for reproducing a recorded signal and it recites the reciprocal

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relationship between time compression or expansion and the three variables a, n, and M. Dependent claims 5-10 further limit claims 11 or 12.

The Board upheld the final rejection of claims 5 and 7-12 under 35 U.S.C. Section 103 as being unpatentable over U.S. Patent 4,757,392 to Awamoto in view of Driessen et al., *An Experimental Digital Video Recording System*, CE-32 I.E.E.E. Transactions on Consumer Electronics 3, Aug. 1986, at 362-70. The Board also upheld the final rejection of claim 6 as being unpatentable over Awamoto and Driessen in view of U.S. Patent 4,542,417 to Ohta.

## DISCUSSION

We review *de novo* the Board's ultimate determination of obviousness. *In re De Blauwe*, 736 F.2d 699, 703, 222 USPQ 191, 195 (Fed. Cir. 1984). Underlying factual inquiries, such as the scope and content of the prior art, differences between the prior art and the claimed invention, and level of ordinary skill in the art are reviewed for clear error. *See In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985).

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

All of the claims except claim 6 stand rejected under 35 U.S.C. Section 103 as being obvious over Awamoto in view of Driessen. 1 Awamoto, the primary reference, discloses a signal processing circuit for a video recording and reproducing apparatus. Awamoto specifically discloses the time expansion of an input signal by a factor of two and the corresponding time compression of an output signal in a manner inverse to that of the time expansion. Further, Awamoto uses two video heads mounted on a rotary drum "of any of a well known video tape loading mechanism such that [the heads] follow parallel tracks skewed relative to the length of video tape." Driessen discloses a recording system using two pairs of heads mounted on piezo-ceramic actuators.

The Board concluded that the subject matter of the claims would have been obvious over Awamoto in view of Driessen, stating that "the time expansion or time compression relationship is satisfied for the expansion of two disclosed [in] Awamoto when a wrapping angle of 360 degrees, one pair of heads and no non-recording intervals are assumed." The Board further asserted that the recognition of the claimed relationship between time expansion/compression and the three variables a, n, and M is "the mere discovery of a relationship that is applicable to [a] prior art apparatus[, and] does not [give] rise to a patentable invention." Thus, in affirming the rejection, the Board first assumed that the claim limitation at issue, the relationship between time expansion/compression and the three variables, was somehow "inherent" in the prior art as shown by Awamoto. The Board also assumed specific values for the claimed variables in order to assert that Awamoto's device satisfies the claimed relationship.

[1] Rijckaert argues that the examiner has not established a *prima facie* case of obviousness and that the examiner's assumptions do not constitute the disclosure of prior art. We agree. Awamoto does not disclose the wrapping angle of the record carrier around the head drum or the number of times that a head pair which comes in contact with the record carrier does not record a signal on the record carrier. Nor does Awamoto discuss the claimed relationship of the three

deficiencies of Awamoto. Thus, the prior art relied upon does not disclose, suggest, or render obvious the claimed invention, either individually or when combined.<sup>3</sup>

Awamoto does not describe the use of time expansion and compression as a means of optimally filling tracks, much less suggest that the three variables of the claims are even a factor in determining the amount of time expansion or time compression. Rather, Awamoto is concerned primarily with processing a high-quality broadcast television signal for use in conventional video machinery, and with compensating for errors introduced to such a signal by a transfer circuit. The Commissioner's assertion "that the [analysis discussed in his brief] and Awamoto demonstrate that the relationship was, in fact, well known in the art" is unavailing. While the court appreciates the Commissioner's thorough explanation of the claimed relationship in his brief, the Commissioner's brief is not prior art. The prior art is Awamoto, and it does not indicate that the relationship is well known in the art nor does it suggest the claimed relationship. *See In re Yates*, 663 F.2d 1054, 211 USPQ 1149, 1151 (CCPA 1981) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference).

To support the Board's affirmance of the rejection, the Commissioner points out that in the recording art, the exact matching of signal time to recording time is an optimal condition, and that this condition would be met by fulfilling the claimed relationship. While the condition described may be an optimal one, it is not "inherent" in Awamoto. Nor are the means to achieve this optimal condition disclosed by Awamoto, explicitly or implicitly. "The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency.]" *In re Oelrich*, 666 F.2d 578# 581-82, 212 USPQ 323, 326 (CCPA 1981) (citations omitted) (emphasis added). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. *See In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Rijckaert also argues that the rejection of dependent claim 6 as being obvious over Awamoto and Driessen in view of Ohta is improper. Ohta discloses an apparatus for compensating for signal loss in a single-head video recorder using a time compression factor of 3/5 (a signal of time period 5t/4 is compressed into a track of time period 3t/4) so that a signal is recorded completely during the time period that it takes the recording head to scan the magnetic tape. Regarding the Ohta patent, the examiner stated, "Ohta was only relied upon to support the idea that other compression factors are used in the prior art. . . ." <sup>4</sup> The relationship between the time expansion/compression and the three variables recited in the claims from which claim 6 depends, which is absent in the combination of Awamoto and Driessen, is not supplied by Ohta. Thus, we agree that the rejection of claim 6 under Section 103 is improper for the reasons set forth above with respect to the other claims.

While the Commissioner criticizes Rijckaert's arguments regarding the Section 103 rejections, the burden to rebut a rejection of obviousness does not arise until a *prima facie* case has been established. In the case before us, it was not.

## CONCLUSION

The decision of the United States Patent and Trademark Office Board of Patent

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Appeals and Interferences affirming the final rejection is reversed.  
*REVERSED*

## Footnotes

Footnote 1. The claims stand or fall together since no separate argument for patentability has been made for each claim.

Footnote 2. The Commissioner admits that other limitations recited in claims 11 and 12 are not found in Awamoto; however, those limitations were not argued before the Board or this court. Thus, we agree with the Commissioner that those limitations are not at issue here.

Footnote 3. The Board also noted that the claims are not "specific" in that they claim the three variables as a "factor" of the expansion or compression time. The Board stated, "claims 11 and 12 fail to say which of expansion time or compression time is factored by the variables, how or when one of the two times is selected based on the variables or how each of the two times is related to the variables." The Board further stated, "the relationship is probably satisfied by any prior art video tape recording and reproducing apparatus that otherwise satisfies the remaining requirements of the claims at bar." While the Board's position implies a possible rejection based upon 35 U.S.C. Section 112, this issue is not before us. In any event, the statement that the relationship is "probably satisfied" by the prior art is speculative and therefore does not establish a *prima facie* case of unpatentability.

Footnote 4. The Board did not specifically address the rejection of claim 6; therefore, claim 6 was considered to be affirmed for the reasons stated by the examiner. *See* 37 C.F.R. Section 1.196(a) (1993).

- End of Case -

